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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,805	09/29/2000	Joseph R. Stonoha	632.0001USU	2958

7590 12/19/2003

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EXAMINER

COSIMANO, EDWARD R

ART UNIT PAPER NUMBER

3629

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/676,805

Applicant(s)

STONOH A ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/29/00 & 10/16/03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
 - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. The drawings are objected to because:
 - A) the following errors have been noted in the drawings:
 - (1) when comparing fig. 16 to the disclosure in the paragraph at page 16, lines 3-17, (as amended October 16, 2003), "Referring to FIG. 16, ... that is continued in FIG. 17.", it can be seen that fig. 16 does not correspond to its description in regard to steps 430, 432, 434, 436, 438 & 440, since it appears that the depicted flow lines do not correspond to the described operation in regard to these steps.
- 2.1 A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
- 2.2 Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.
3. The disclosure is objected to because of the following informalities:
 - A) as required by 37 CFR § 1.84(p(5)) and 37 CFR § 1.121(e) the specification lacks an explicit reference to the nature of:
 - (1) reference legend(s):
 - (a) 170 of fig. 8 in the paragraphs between page 10, line 16, and page 11, line 13, "Referring to FIG. 8 ... to be placed in a data file.
 - (2) how the program proceeds after box(es):

(a) 360 of fig. 13 if the inquiry is "YES" as described in the paragraph at page 14, lines 9-30, "Referring to FIG. 13, ... which is continued in FIG. 17."; and

(b) 438 of fig. 16 if the inquiry is "NO" as described in the paragraph at page 16, lines 3-17, "Referring to FIG. 16, ... that is continued in FIG. 17."

In this regard, it is noted that merely mentioning a number with out mentioning the device or operation of the step relies on the drawing to provide support for the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

Appropriate correction is required.

4. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

5. Claims 37 & 60 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5.1 Claim 37 is confusing since this claim lacks limitations (d) & (e). In this regard it is noted that claim 37 recites an additional limitation (f), however claim 37 is directly dependent from claim 28 which only recites limitations (a), (b) & (c), therefore it is unclear and confusing what happen to limitations (d) & (e).

5.2 Claim 60 is confusing since this claim lacks limitations that introduce a "first entry", a "second entry", a "third entry", and a "fourth entry". In this regard it is noted that claim 60 recites an "fifth entry", however claim 60 is directly dependent from claim 50 which only recites limitations "first means", "second means" and "third means", therefore it is unclear and confusing what happen to limitations a "first entry", a "second entry", a "third entry", and a "fourth entry".

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5.3 For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6.1 Claims 1-7, 9-16, 18-25, 27-60, 70-72 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Drisko (4,718,784).

6.1.1 In regard to claims 1, 5-7, 9, 10, 14-16, 18-25, 27-37, 39, 41, 42, 45-48, 50, 52, 53, 56-59 & 70-72, Drisko ('784) discloses a computer system for designing and printing labels. In the system of Drisko ('784) a processor under a control program stored in a memory operates the system the system to Drisko ('784) to permit the user to use a input means to make various entries of data into the system and to display the entered data. Where the various entries of data include the designation of:

- A) the location/position of text and/or graphics that is to appear on the label;
- B) the content of the text and/or graphics that is to appear on the label;
- C) the size of the label;
- D) the font size and appearance, e.g. bold type;
- E) whether or not a barcode is to appear on the label;
- F) the arrangement of the blank labels on the print stock; and
- G) a designation of the labels to be printed.

It is further noted that for each label to be generated, the user may select either previously defined label designs or create custom labels, hence, consecutive labels may not be related to one another.

6.1.2 Once the labels have been designed, the user may then instruct the processor to print the labels on blank label stock.

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6.1.3 In regard to the sequence of numbers assigned to the labels, a skilled artisan would have recognizes this feature of the invention as non functional descriptive material, since (1) the claim fails to recite that any number is assigned to any of the labels; and; or (2) even if a number had been assigned, neither the assignment of a number or the sequence of numbers affects how the invention as a whole would operate. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or
- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

6.1.4 In regard to claims 2-4, 11-13, 40, 43, 44, 51, 54 & 55, it is noted that applicant has failed to define the exact nature of the "palette", hence this word is given it common ordinary meaning. In view of this one of ordinary skill would know that it is common practice to set forth to the user various options by presenting to the user a palette or a display showing a number of possible positions/colors/fonts available to the user. The user then would select the desired item from one of the available palettes. Note for example a color palette or a graphics palette or a font palette or a palette or label designs.

6.1.5 In regard to claim 38, 49 & 60, the system of Drisko ('784) further keeps track of the number of labels printed and assigns consecutive serial numbers to each label if the user has designated this feature.

6.1.6 In regard tot eh interface of claims 70-72, it is noted that the user of the system of Drisko ('784) would require an user interface in order to operate the system of Drisko ('784).

7. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

7.1 Claims 8, 17, 26 & 61-69 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Drisko (4,718,784) as applied above to claims 1-7, 9-16, 18-25 & 27-60 and further in view of an obvious variations.

7.1.1 It is noted in regard to claims 8, 17 & 26, that Drisko ('784) does not permit the user to designate a rotational orientation for the barcode, however, Drisko ('784) does permit the user to define the exact location on the barcode on the label relative to the other information on the label. Since the teachings of Drisko ('784) permit the user of Drisko ('784) could define a position and orientation for the barcode which is rotated from the position and orientation of the remaining information by not excluding this possibility, it would have been obvious to one of ordinary skill at the item the invention was made that the system of Drisko ('784) does permit the user to define a rotational orientation for the barcode and/or text that is to appear on the label.

7.1.2 It is noted in regard to claims 60-69, that Drisko ('784) does not permit the user to designate a warning level to alert the user of a low supply of labels, however, Drisko ('784) does track the number of labels generated during printing. Further it would have been clear to a skilled artisan that it is not desirable to start a print job that could not be completed because

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of a low supply of labels would affect other systems and potentially cause problems for the user. Since, the teachings of Drisko ('784) do in fact track the number of labels printed, it would have been obvious to one of ordinary skill at the time the invention was made that the system of Drisko ('784) could be modified to use alterable alert levels so as to prevent unnecessary interruption during the production of a label print job, since such interruption would affect associated system and may cause problems for the user.

8. Response to applicant's arguments.

8.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been overcome by applicant's last response.

8.2 As per the 35 U.S.C. § 102 rejection, since:

A) since one of ordinary skill would have recognized that the collection of labels designed in Drisko (4,718,784) is a "single job" when related to either (1) the user designing the labels; or (2) the actual production of the labels, applicant's arguments with regard to this feature and claims 1-27 are non persuasive.

B) since one of ordinary skill would have recognized from the language of the claims that the phrase "is unrelated in numerical sequence to any of the other labels" is non functional descriptive material, since (1) the claim fails to recite that any number is assigned to any of the labels; and; or (2) even if a number had been assigned, neither the assignment of a number or the sequence of numbers affects how the invention as a whole would operate, hence, applicant's arguments with regard to this feature and claims 1-27 are non persuasive.

C) in regard to the use of various pallets as recited in claims 28, 39 & 50, since one of ordinary skill would have recognized that the system of Drisko (4,718,784):

(1) permits the user to design a label by selecting the colors/fonts/text which is to appear on the label; and

(2) the overlapping of some text/color combinations would render the label unintelligible or unusable;

(3) the font size would govern the positioning of the text;

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one of ordinary skill at the time the invention was made would have recognized that the system of Drisko (4,718,784) would inherently include the ability for the user of placing the desired color/text any appropriate/desired location on the label, hence, applicant's arguments with regard to this feature and claims 28-60 are non persuasive. It is further noted that since the claims fail to distinguish exactly how the position pallet works or exactly what the positional pallet is, any means that allows the user to designate a position would be considered a positional pallet.

8.3 As per the 35 U.S.C. § 103 rejection, since:

A) in regard to claims 8, 17, 26 & 61-69, it is respectfully noted that applicant has clearly claimed the functional operations of:

(1) positioning color, font, graphic design, etc.; and

(2) selecting a color, font, graphic design, etc. from among a number of various possible predefined colors, fonts, graphic designs, etc. that are available to the user; and

(3) keeping track of the number of labels used;

while Drisko (4,718,784) teaches these vary operations, hence, a prima facie case has been established and one of ordinary skill would be charged with the knowledge of how to display various pallets to the user and how the user may select one or more of the items in the pallet and keeping track of inventory of labels. Since applicant has not shown that one of ordinary skill would not have had this knowledge, applicant's arguments with regard to this features and claims 8, 17, 26 & 61-69 are non persuasive.

8.4 In regard to claims 1-72, it is respectfully noted that applicant seems to e arguing what is disclosed in the specification about the claimed limitations instead of what is actually has been recited in the, hence applicant is arguing unclaimed distinctions and merits and therefore applicant's arguments with regard to the features of claims 1-72 are non persuasive.

9. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

10.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

10.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

10.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

12/17/03


Edward R. Cosimano
Primary Examiner A.U. 3629